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EXAMINER

GRAYSAY, TAMARA L

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/748,579

**Applicant(s)**

BRACCHITTA ET AL.

**Examiner**

Tamara L. Graysay

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>22 Dec 2000</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The Office no longer checks the date of execution of the declaration. In accordance with MPEP § 602.05, applicants are reminded that they have a continuing duty of disclosure under 37 CFR 1.56.

### ***Drawings***

2. The drawings are objected to because the word “continued” is misspelled at the text describing the arrowed connector between elements 80 and 90 in Figure 2.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The disclosure is objected to because of the following informalities: The sentence at page 8, lines 12-14, does not make sense to the examiner.

Appropriate correction is required. No new matter should be added.

***Claim Objections***

4. The claims are objected to because of the following: At line 3 of claim 22, the word “and” should be inserted after the comma, and line 4, the comma should be deleted. At line 12 of claim 23, the word “for” should be inserted after “goals” to avoid a grammatical error. The preamble terminology “system” of claims 32-42 is inconsistent with the preamble of independent “apparatus” claim 31.

Appropriate correction is required. No new matter should be added.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-14, 15-24, 25-30, and 43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

a. Regarding process claims 1-14, although the disclosure is limited to a practical application within the technological arts insofar as the method and system utilize a computer for managing resource allocation within an intellectual property portfolio, the process as recited in claims 1-24 is not limited to a practical application within the technological arts. First, a practical application is one that is useful, concrete, and tangible. Arguably, the process for managing resource allocation including the claimed

steps is useful, because when the steps are performed they are intended to benefit the intellectual property portfolio owner. However, the process as claimed does not produce a concrete and tangible result. A concrete and tangible result is one that is reproducible, for example. In the present application, the process does not produce a result that is reproducible. The process sets forth abstract ideas broadly claimed as a mathematical algorithm. The preamble and body of claims 1-14 are "for managing resource allocations" without any result being set forth in the process. Second, mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, the process lacks a tie to any technological art. The process claims do not recite any limitations that involve a technology, and the claimed process steps do not require use of any technology to implement the invention. The steps of determining, assigning, apportioning, and managing, as recited in claims 1-14, are all accomplished in the abstract without applying, involving, using, or advancing any technological art. Each of the steps may be accomplished manually, or using pencil and paper. In conclusion, there is no result claimed, only "managing resource allocation" and there is no tie to a technological art since each of the claimed steps is accomplished in the abstract without computer implementation, for example. Therefore, claims 1-14 are directed to nonstatutory subject matter.

b. Regarding process claims 15-24, although the disclosure is limited to a practical application within the technological arts insofar as the method and system utilize a computer for managing resource allocation within an intellectual property portfolio, the process as recited in claims 15-24 is not limited to a practical application within the technological arts. First, a practical application is one that is useful, concrete, and tangible. Arguably, the process for managing resource allocation including the claimed steps is useful, because when the steps are performed they are intended to benefit the intellectual property portfolio owner. However, the process as claimed does not produce a concrete and tangible result. A concrete and tangible result is one that is reproducible, for example. In the present application, the process does not produce a result that is reproducible. The process sets forth abstract ideas broadly claimed as a mathematical algorithm. The preamble and body of claims 15-24 are “for managing invention disclosures” without any result being set forth in the process. Second, mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, the process lacks a tie to any technological art. The process claims do not recite any limitations that involve a technology, and the claimed process steps do not require use of any technology to implement the invention. The steps of determining, apportioning, tracking and comparing, and proactively

managing, as recited in claims 15-24, are all accomplished in the abstract without the applying, involving, using, or advancing any technological art. Each of the steps may be accomplished manually, or using paper and pencil. In conclusion, there is no result claimed, only “managing invention disclosures” and there is no tie to a technological art since each of the claimed steps is accomplished in the abstract without computer implementation, for example. Therefore, claims 15-24 are directed to nonstatutory subject matter.

c. Regarding apparatus claims 25-30, although the disclosure is limited to a practical application within the technological arts insofar as the method and system utilize a computer for managing resource allocation within an intellectual property portfolio, apparatus claims 25-30 are limited to a collection of data (first and second fields of data collected over a first and second period of time, respectively), i.e., merely nonfunctional descriptive material, and thus are nonstatutory. Even though the preamble recites the term “data structure” there is no data structure positively claimed with its functionality; that is to say there is no interrelationship among the data, but rather a collection of data in the first and second fields that are capable of being compared. Moreover, even if construed as data structure there is no positive recitation in the claims of functionality imparted to the data or its structure, therefore the claimed invention lacks a practical application. Therefore, claims 25-30 are directed to nonstatutory subject matter.

d. Regarding apparatus claim 43, the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being. The claim recites “means for proactively managing” which is a function performed by a person or team of technical

people, e.g., invention disclosure creation, invention disclosure evaluation for patent searching, and invention disclosure evaluation for patent application filing. Therefore, claim 43 is directed to nonstatutory subject matter.

e. Regarding apparatus claim 56, the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being. The claim recites “means for proactively managing” which is a function performed by a person or team of technical people, e.g., invention disclosure creation, invention disclosure evaluation for patent searching, and invention disclosure evaluation for patent application filing. Therefore, claim 56 is directed to nonstatutory subject matter.

6. Regarding apparatus claims 31-42, by reciting means-plus-function language 35 U.S.C. 112, sixth paragraph, has been invoked. The claimed means-plus-function limitation of managing resource allocation for an activity “by determining the difference between the actual resource usage and the resource allocation” has been interpreted to include the structure recited in the specification, and equivalents thereof. Thus, the claims are limited to a specific machine or manufacture and are directed to statutory subject matter.

7. Regarding apparatus claims 44-55, by reciting executable instructions stored on a readable storage device, applicant has limited the claim so that the instructions (a method performed by a machine) impart functionality to either the data or to the computer. Thus, the claims are limited to more than mere data, but rather the structural and functional interrelationship to the medium, and are directed to statutory subject matter. Although no specific programming code is appended to the specification, one of ordinary skill in the computer



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programming art would know how to make and/or use the invention without undue experimentation.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-8, 11-14; 15-17, 20-24; 25, 29-30; and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsu (article, Managing the university technology licensing process: findings from case studies).

a. Regarding claim 1, Hsu discloses a method for managing resource allocations within an intellectual property portfolio comprising determining resource capacity (potential value of a licensed invention contrasted with the human resources needed to develop and process invention disclosures, patents, licenses, etc.) for an intellectual property activity (for example, invention disclosures that are patented and licensed); assigning technical attributes (disclosed technology fields or tags include promising, potentially important, and embryonic technologies, p.1, ¶3); apportioning resource capacity (decisions to file a patent application for or to license an invention disclosure) based on a value (unworthwhile, scarce marketing resources, etc., p.3, ¶3); obtaining actual resource usage (licensing officer, inventor or faculty time, office staff); and managing apportioned resource (decision to file patents for invention disclosures, and decision to pursue license(s) for patented inventions) for the activity. Hsu discloses a tracking system that is

inherent to the process insofar as the universities that were studied provided statistics summarizing their activities.

b. Regarding claims 2-4, Hsu discloses that the license office can be classified on the basis of a commitment spectrum and that decisions to allocate resources are based on various factors including historical data. This disclosed process of using historical data to make patent activity managing decisions inherently includes a determination between actual resource usage and apportioned, or allocation, resources within a time period. As noted regarding claim 1 above, Hsu includes assigning technical attributes (disclosed technology fields or tags include promising, potentially important, and embryonic technologies, p.1, ¶3).

c. Regarding claim 5-8, Hsu discloses a dynamic adjustment of the apportioned resource (commitment decision based on whether disclosure is likely to be in the top half of disclosures received, p.2, ¶3) and the use of periodic reports insofar as at least yearly summaries are mentioned. One example provided by Hsu is yearly statistics (longer time period) that are periodically compared to the current year (shorter time period) as noted on p.2, ¶3.

d. Regarding claim 11, Hsu includes evaluating invention disclosures, for example.

e. Regarding claims 12-14, Hsu discloses setting intellectual property development guidelines that are commensurate with the goals of the university and understanding the current intellectual property portfolio insofar as the goals include royalty revenue and the benefit of the current technology to the related business or marketplace. As noted regarding claim 1 above, Hsu includes assigning technical attributes (disclosed

technology fields or tags include promising, potentially important, and embryonic technologies, p.1, ¶3).

f. Regarding claim 15, Hsu discloses a method for managing invention disclosures comprising determining a desired number of invention disclosures based on available resources (invention disclosures are based on the number of faculty, the technology office staffing, and budget); apportioning desired number of invention disclosures based on a value assigned to each technical attribute (decisions to file a patent application for or to license an invention disclosure based on technology fields or tags include promising, potentially important, and embryonic technologies, p.1, ¶3; and the value of technologies, p.4, last paragraph); tracking actual number of disclosures and comparing actual with desired disclosures; proactively managing the invention disclosure evaluation (marketing strategy P.7).

g. Regarding claims 16 and 20, Hsu discloses a tracking system that generates a report of the actual and desired invention disclosures insofar as the Hsu data provided annual summaries of the invention disclosures for several universities.

h. Regarding claim 17, Hsu discloses a report for a first time period that is the previous year, and a second time period that is the current year (commitment decision based on whether disclosure is likely to be in the top half of disclosures received, p.2, ¶3) and the use of periodic reports insofar as at least yearly summaries are mentioned. One example provided by Hsu is yearly statistics that are periodically compared to the current year as noted on p.2, ¶3, i.e., the first time period is longer than the second time period.

- i. Regarding claim 21, Hsu discloses technical attributes comprise a technology-based descriptor (disclosed technology fields or tags include promising, potentially important, and embryonic technologies, p.1, ¶3).
- j. Regarding claim 22, as noted with regard to claim 20 above, Hsu discloses proactively managing comprising adjusting invention disclosure evaluation.
- k. Regarding claim 23, Hsu discloses the invention of claim 23 as noted with regard to claims 15-22 above.
- l. Regarding claim 24, Hsu discloses setting intellectual property development guidelines that are commensurate with the goals of the university and understanding the current intellectual property portfolio insofar as the goals include royalty revenue and the benefit of the current technology to the related business or marketplace.
- m. Regarding claims 25 and 30, Hsu discloses a first set of data representing actual resource usage over a first time period (current year) and a second set of data representing actual resource usage over a second time period (historical data, longer time period). The data is compared to facilitate resource allocation management. The intellectual property activity comprises at least evaluating invention disclosures.
- n. Regarding claim 29, Hsu discloses a third set of data representing budget goals for a given time period (p.1, ¶2).
- o. Regarding claim 43, Hsu inherently includes an apparatus including means for determining a desired number of invention disclosures and means for apportioning the desired number based on value assigned to a technical attribute (see p.3, ¶2-4 for a discussion of invention disclosures and their technical attributes that will help maximize a

university's social benefit, avoid a stigma of non-discriminatory technological pursuits, and balance risk). Hsu discloses a tracking system that is inherent to the process insofar as the universities that were studied provided statistics summarizing their activities. Hsu also discloses means for proactively managing invention disclosure evaluation (technologies licensing offices decide to pursue by filing for a patent, p.1, ¶3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9-10, 18-19, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu (article, Managing the university technology licensing process: findings from case studies).

Hsu discloses historical and current time frames. Generally, the time frames are intended to compare the current year's invention disclosures with historical data. For example, at page 2, ¶3, if 50 % is the historical amount of patent applications filed for invention disclosures, then the current year invention disclosures are reviewed keeping in mind the historical amount of 50%. In this example, the first time period is the current year and the second time period, thus Hsu lacks the second time period including the first time period. The examiner takes official notice that data is routinely analyzed over a time period suitable for the particular analysis, and that it is notorious in the field of administrative analysis to use a particular time period including weekly, biweekly,

monthly, bi-monthly, quarterly, annually, semi-annually, etc. The time period manipulation of data in any manner suitable for analysis by the institution would have been obvious to one of ordinary skill in the art of operations research. For example, an institution that has had a change in administration or budget would also include the first time period in the second time period to view the overall affect that the administrative or budget change has on the institutional technology office, or simply to analyze the current fiscal year or to compare the current fiscal year to a prior fiscal year or years. Regarding claims 18 and 26, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hsu to include analysis where the second time period is inclusive of the first time period. An institution that has a goal of increasing patent application filings would include the first time period in the second time period in order to determine whether the patent application filings for the current year have any impact on the overall historical data. Regarding claims 9, 19, and 27, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hsu so that the first time period is less than five months and the second time period is at least two times the first time period, in order to analyze a snap shot for institution reporting purposes. For example, the second quarter of a fiscal year compared to the first half of the fiscal year, or the third quarter of the fiscal year compared to the first three quarters of the fiscal year, and the like. Regarding claims 10 and 28, the claimed time frames are commensurate with standard reporting for accounting purposes. A two to four month time period would accommodate quarterly analysis. For example, a first quarter analysis compared to the first quarter average over the past three years, a third quarter

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analysis as compared to the first three quarters, or the last quarter compared to the overall year.

10. Claims 31-42; 44-55; and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nummelin (US-6308164) in view of Hsu (article, Managing the university technology licensing process: findings from case studies).

Nummelin discloses a tracking apparatus for managing a project. The apparatus includes means for determining resource capacity (development of a project plan, c.7, l.46-56; resources within the organization or enterprise, c.2, l.10-14; c.2, l.55-61; c.3, l.64-67; c.4, l.5; c.5, l.44-46, etc.); means for assigning technical attributes (secondary category/type information, c.2, l.10-14, ref.330) to an activity; means for apportioning resource capacity (); means for obtaining actual resource usage (each task is defined in terms of resources used, c.5, l.43-50); and means for managing resource allocation (project managers monitor project and task status, project resources receive task assignments and input task status at workstations, c.5, l.65-c.6, l.1).

Nummelin lacks the intellectual property activity.

Hsu teaches an analysis of an intellectual property portfolio and the activities within and related to the portfolio.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Nummelin to include data related to an intellectual property portfolio, as taught by Hsu, in order to effectively manage the invention disclosures within the portfolio and to analyze the resources allocated to maintain the portfolio.

Further regarding claims 44-56, the apparatus of Nummelin, as modified by Hsu, includes a computer readable storage device (localized and secondary databases, ref.112, 116, 122, 124, 132, 134) that is capable of performing the process as recited in the claims.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Watson (article, Invention triage; allocating resources for maximum benefit) teaches an invention disclosure evaluation system that takes into consideration the goals and budget of a technology transfer office and allocates resources dependent upon the value that an invention disclosure has to an institution. An invention disclosure is classified by its technology and pursued according to its protectability, novelty and market size, and consistency with institutional mission.
- Johnson (US-5991876) cited by applicant, teaches an electronic management system for tracking works, including invention disclosures.
- Murtha (article, Companies urged to see the potential in their rights portfolio) teaches resource allocation based on the value of a patent in a technological area, for example, generating income for an invention by licensing it outside an institution's area of expertise.
- Business News New Jersey (article, Emmett Murtha on how to protect and profit from the intellectual property your company has) teaches value of intellectual property as a factor in decision making for an institution.



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- Ukkola (article, Making your assets work) teaches the importance of managing and facilitating value generating activities associated with intellectual assets by identifying, assessing, and valuing assets and processes.
- Bosworth (article, Research and development, intangible assets and the performance of large Australian companies) teaches technological opportunity classification (Bureau of Industry Economics) (p.20, 33).
- Powell (article, Tracking patents with IPAM) teaches categorization of patents to observe trends in a particular technological area (p.34, c.2-3).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (703) 305-1918. The examiner can normally be reached on Mon - Thu and alternate Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tlg 12/7/04

  
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